

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 15, 2004 (the "Office Action"). In the Office Action, the Examiner rejects Claims 1-24. Applicants respectfully request reconsideration and favorable action in this case.

Consideration of Information Disclosure Statement

Applicants filed an Information Disclosure Statement on August 5, 2002 (the "IDS") and have received no indication that the Examiner has considered the references cited in the IDS. The IDS was filed before the mailing of a first Office Action on the merits. Applicants respectfully request the Examiner to consider the references cited in the IDS, and in the event a patent issues on this Application, that these references be printed on the face of the issued patent. Furthermore, Applicants respectfully request a copy of the PTO Form 1449 for the IDS indicating the Examiner's consideration of the references.

Drawing Amendment

Applicants submitted a request for drawing amendment of Figure 1, along with both a marked-up version and a Replacement Sheet including revised Figure 1, with the Applicants' Response to Office Action filed on September 4, 2003. In the Office Action mailed January 15, 2004, there is no indication that this drawing amendment has been approved. Applicants respectfully request approval of the drawing amendment filed September 4, 2003.

Section 103 Rejections - Derby/Ahmed

The Office Action rejects Claims 1-6, 9-14 and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,483,522 to Derby et al. ("Derby") in view of U.S. Patent No. 5,432,783 to Ahmed et al. ("Ahmed"). Applicants respectfully traverse these rejections for the reasons discussed below.

A. No Motivation to Combine

In response to Applicants' indication that the Examiner failed to cite the specific understanding or principle within the knowledge of one skilled in the art that would motivate the combination of *Ahmed* and *Derby*, the Examiner states that "in Ahmed the motivation for

asymmetric connections is to allow for a larger bandwidth in one direction because inherently more bandwidth is required in the one direction (col. 2, lines 6-8 and 20-24)." *See* Office Action, ¶ 2. The Examiner attempts to cite a reason that asymmetric connections were used in *Ahmed*. However, merely citing a reason that asymmetric connections were used in *Ahmed* does not satisfy the requirement. Instead, the Examiner is required to provide a motivation to combine *Ahmed* with *Derby*, which is an essential component of an obviousness holding. *See, e.g., In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (citing *Brown v. Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)).

Moreover, the portions of *Ahmed* cited by the Examiner in response to Applicants' indication of a failure to cite the required motivation do not support the Examiner's contention that it would have been obvious to combine *Ahmed* with *Derby*. Nor do such cited portions support the Examiner's statement that "inherently more bandwidth is required in the one direction." The Examiner cites portions of *Ahmed* that state:

Virtual channel connections and virtual path connections are bi-directional with either symmetric or asymmetric cell transfer capability. . . . Even though a customer can contract for a peak cell transfer rate on an ATM connection, in principle, the user could exceed the negotiated traffic parameter up to the maximum capacity of the physical facility.

Ahmed, col. 2, lines 6-8 and 20-24. However, this portion of *Ahmed* cited by the Examiner does not relate in any way to a motivation to use asymmetric connections in the teachings of *Derby*. This cited portion of *Ahmed* does not provide the required actual evidence that would motivate one skilled in the art to combine the teachings of *Ahmed* and *Derby*. As the Federal Circuit has stated:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted)¹;

¹ *See also In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the

see also M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.") As the Federal Circuit has further stated, "[p]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together elements of *Derby* and *Ahmed*. The Examiner has failed to cite evidence providing the specific teaching in the art that would motivate one to combine *Ahmed* with *Derby*.

B. Derby Teaches Away from the Combination

In response to Applicants' arguments that *Derby* teaches away from the use of asymmetric connections, the Office Action states that a "reverse optimal path is not required in *Derby* and therefore a reverse path from a destination to a source following the same path as from the source to the destination does not preclude asymmetric connections or links in *Derby*." *See* Office Action, ¶ 1. However, the lack of a statement in *Derby* that a reverse optimal path is required does not mean that *Derby* does not specifically teach away from the use of asymmetric connections. A prior art reference must be considered in its entirety, including disclosures that teach away from the claimed invention. *See* M.P.E.P. 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) and 2145 X.D. "It is improper to combine references where the references teach away from their combination." *See* M.P.E.P. 2145 X.D.2. (citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)). The question is not whether particular disclosures in *Derby* are required; the question is whether *Derby* includes disclosures that teach away from the proposed combination.

It is clear that disclosures in *Derby* teach away from the use of asymmetric connections between its intranode traffic bearing components. *Derby* discloses a routing

herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at"

diagram and routing field for a message from a source node 70 to a subnode 81 of a destination node 72 via subnodes 75 and 79. *See Derby*, Figure 8 and col. 9, lines 23-55. *Derby* also discusses a reverse path for routing a message from subnode 81 of destination node 72 to source node 70. *See id.*, col. 9, lines 57-62. In this discussion, *Derby* indicates that reverse path accumulation enables the destination user application to send a reply to the message. *See id.* This is accomplished by merely reversing the original routing path such that the message travels from subnode 81 to node 70 via subnodes 79 and 75. *See id.* and Table 1. The indication that it is reverse path accumulation that enables message to travel from a destination node to a source node specifically teaches away from the use of asymmetric connections in *Derby*, because if the connections in *Derby* were asymmetric, then there would be an optimal routing path from the destination to the source that is different from the mere reversal of the original path between the source and the destination taught by *Derby*. Such a case would make the disclosure concerning reverse path accumulation in *Derby* immaterial and illogical. Therefore, using asymmetric connections in *Derby* directly conflicts with the teachings of *Derby*.

Therefore, for at least the reasons stated above, Applicants respectfully submit that Claim 1 is patentable over the cited art and request that the rejection of Claim 1 be withdrawn.

Claims 2-6 depend from Claim 1 and therefore include each of the elements of Claim 1. Applicants thus respectfully request that the rejection of Claims 2-6 be withdrawn.

The Office Action rejects Claims 9 and 17 using the same obviousness rejection used to reject Claim 1. *See Office Action, ¶ 1.* However, as discussed above with regard to Claim 1, there is no actual evidence providing the required motivation to combine *Derby* with *Ahmed* as contended by the Office Action and *Derby* specifically teaches away from such a combination. For at least these reasons, Applicants respectfully submit that Claims 9 and 17 are patentable over the cited art and request that the rejections of Claims 9 and 17 be withdrawn.

the claimed invention.).

Claims 10-14 depend from Claim 9, and Claims 18-22 depend from Claim 17. Applicants thus respectfully request that the rejections of Claims 10-14 and 18-22 be withdrawn.

Section 103 Rejections - Derby/Ahmed/Le Boudec

The Office Action rejects Claims 7-8, 15-16 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Derby* in view of *Ahmed* and further in view of U.S. Patent No. 6,016,306 to Le Boudec et al. ("*Le Boudec*"). Applicants respectfully traverse these rejections for the reasons discussed below.

Claims 7-8 depend from Claim 1, Claims 15-16 depend from Claim 9 and Claims 23-24 depend from Claim 17. The Office Action rejects Claims 7-8, 15-16 and 23-24 as being unpatentable over *Dewey* in view of *Ahmed* as applied to Claims 1, 9 and 17. However, as discussed above with regard to Claim 1, there is no actual evidence providing the required motivation to combine *Derby* with *Ahmed* as contended by the Office Action and *Derby* specifically teaches away from such a combination. For at least these reasons, Applicants respectfully submit that Claims 7-8, 15-16 and 23-24 are patentable over the cited art and request that the rejections of these claims be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTT S L.L.P.
Attorneys for Applicants



Chad C. Walters
Reg. No. 48,022

Date: March 15, 2004

CORRESPONDENCE ADDRESS:

BAKER BOTT S L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
(214) 953-6511

Customer Number: **05073**